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TRANSMITTAL LETTER (General - Patent Pending)	Docket No. ELRP:101_US_
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In Re Application Of: MANCUSO, Anthony J. et al.

Application No. 09/954,766	Filing Date 9/18/2001	Examiner John Quoc Nguyen	Customer No. 24041	Group Art Unit 3654	Confirmation No. 8533
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Title: COIL REEL HOLD-DOWN DEVICE

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Dated: October 18, 2006

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U.S. Patent Application 09/954,766
Attorney Docket No.: ELRP:101_US_

**IN THE UNITED STATES PATENT AND TRADEMARK
OFFICE**

Appellants: **MANCUSO, Anthony J. et al.**

Examiner: **Nguyen, John Quoc**

U.S. Patent Application No.: **09/954,766**

Group Art Unit: **3654**

For: **COIL REEL HOLD-DOWN DEVICE**

Filed: **September 18, 2001**

Customer No. **24041**

Confirmation No. **8533**

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AMENDED APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Honorable Sir:

Appellants respectfully appeal the decision of the Examiner to finally reject Claims 1-12, as set forth in the final Office Action of May 12, 2005. A Notice of Appeal was timely filed by the Appellants on August 2, 2005. An Appeal Brief was filed by Appellants on September 29, 2005. This Amended Appeal Brief is in response to a Notice of Non-Compliant Appeal Brief dated September 19, 2006. The required Appeal fee was included with the Appeal Brief filed September 29, 2005.

A **Claims Appendix** follows page 12 of this paper.

An **Evidence Appendix** follows page 14 of this paper.

A **Related Proceedings Appendix** follows page 15 of this paper.

REAL PARTY IN INTEREST

The Real Party in Interest in this matter is Elrae Industries, Inc., assignee.

STATUS OF CLAIMS

The application originally contained 12 claims.

Claims 1-12 stand as finally rejected.

Claims 1-12 are the subject of this Appeal.

STATUS OF AMENDMENTS

There are no amendments filed subsequent to final rejection.

SUMMARY OF THE CLAIMED INVENTION

The present invention relates to a free-standing coil reel hold-down device which comprises a base plate operatively arranged to be secured to a floor; a snubber arm pivotably mounted to the base plate and arranged for pivoting rotation about a pivot point, the snubber arm including a first section and a second section disposed at an obtuse angle with respect to one another; and, a stand-alone means for effecting a pivoting movement of the snubber arm relative to the base plate.

1. Claim 1

Claim 1 recites free-standing coil reel hold-down device including a base plate operatively arranged to be secured to a floor; a snubber arm having integral first and second sections arranged at an obtuse angle to one another, and actuator mounted to the base plate. The snubber arm is pivotably mounted to the base plate at a first end of the first section of the snubber arm and arranged for pivoting rotation about a pivot point proximate the base plate. The snubber arm is arranged to effect a pivoting movement of the snubber arm relative to the base plate. The actuator is connected to the first section of the snubber arm between the pivot point and the second section of the snubber arm.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claim 6 is indefinite under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Appellants regards as the invention?
2. Whether Claims 1-6 and 9-11 are novel under 35 U.S.C. § 102(e) and therefore patentable over Welp et al. (USPN 5,518,199)?
3. Whether Claims 7, 8, and 12 are non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over Welp et al. (USPN 5,518,199)?

ARGUMENT

1. Whether Claim 6 is indefinite under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Appellants regards as the invention?

A.) Summary of the Rejection: In the May 12, 2005 Office Action (hereinafter referred to as the Office Action) the Examiner rejected Claim 6 as indefinite under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Appellants regards as the invention. The Examiner stated: "Claim 6 recites the limitation "means for effecting a pivoting movement". There is insufficient antecedent basis for this limitation in the claim. All claims should be revised carefully to correct all other deficiencies similar to the ones noted above. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action."

B.) The References cited by The Examiner: The Examiner cited 35 U.S.C. § 112, second paragraph, which states:

“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention. There are two separate requirements set forth in this paragraph: (A) the claims must set forth the subject matter that Applicant regard as their invention; and (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

The first requirement is a subjective one because it is dependent on what the Applicant for a patent regard as their invention. The second requirement is an objective one because it is not dependent on the views of Applicant or any particular individual, but is evaluated in the context of whether the claim is definite - i.e., whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.”

C.) Arguments

Appellants respectfully submit that the scope of Claim 6 would be clear to one skilled in the art based on the limitations of Claim 1, which describe the pivoting movement. Appellants courteously request that the rejection be removed.

2. Whether Claims 1-6 and 9-11 are novel under 35 U.S.C. § 102(e) and therefore patentable over Welp et al. (USPN 5,518,199)?

A.) Summary of the Rejection: In the Office Action, the Examiner rejected Claims 1-6 and 9-11 under 35 U.S.C. §102(b) as being anticipated by Welp et al. (USPN 5,518,199). The Examiner stated: “Note the coil reel hold-down device comprising arm 13 having first and second sections as claimed. The arm is pivoted to the "base plate" 11 secured to a floor via member 9 and the frame of the machine and being moved by a cylinder device to engage wheel/roll 15 with the roll 3. The angle between the first and second sections of arm 13 is about 120 degrees.” The specific basis for this rejection appears to be “Fig. 1.”

B.) The References cited by The Examiner: For purposes of providing background, Appellants briefly discusses the references cited by the Examiner.

1.) Welp: (Appellants have assigned numerical designators when possible, however, this was not always possible due to inconsistencies in the nomenclature used by Welp) Elongated support roller 5 is centered on and rotatable about horizontal axis A and radially engages at least one row of takeup rolls 3 coaxial to a takeup-roll axis parallel to support-roller axis A and including at least one central roll and a pair of end rolls axially flanking the central roll. A paper web 1 is fed to the support roller and passes through cutting device 6 between the web supply and the support roller for slitting the web into a plurality of strips including at least one central strip and a pair of end strips flanking the end strip. The central and end strips pass at least partially around the support roller and are wound on the respective central and end rolls. The support roller is rotated about its axis so that the strips wind at least partially around the support roller and at least the central roll is rotated by engagement with the support roll. Respective end-roll periphery drives 17 and 18 radially engage the end rolls for rotating same at a greater peripheral speed than the support roller.

C.) Arguments

1.) The reference cited by the Examiner does not describe each and every element of the claimed invention, either expressly or inherently.

35 U.S.C. §102(b) provides that "a person shall be entitled to a patent unless the invention was patented or described in a printed publication . . . more than one year prior to the date of the application." Accordingly, a rejection based on anticipation requires that the four corners of a single, prior art document describe each and every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See *Atlas Powder Co. v. Ireco, Inc.*, 51 U.S.P.Q.2d 1943, 1947 (Fed. Cir. 1999).

a.) Welp does not teach a floor.

Claim 1 recites: "a base plate operatively arranged to be secured to a *floor* (emphasis added);" There is no reference to a floor in Welp. For example, Figure 1 of Welp and the description of Figure 1 in the specification do not show or describe a floor. According to MPEP 608.02.IX (specifically, page 600-99), the cross-hatched areas shown in Figure 1 are metal. See the example in the upper left hand corner of page 600-99. Given the shape of the cross-hatched area and its metallic

composition, there is no basis for assuming that Welp intended (but did not mention anywhere in the specification) the cross-hatched areas to be a floor. Since Welp does not teach a floor, Welp cannot teach securing any part of his invention to a floor.

Alternately stated, Welp is silent regarding the support structure associated with his invention. For example, Welp's device could be designed to be part of another, larger machine/structure or to be supported by beams over a pit or by an overhead support structure.

b.) Welp does not teach securing slide 11 to a framework.

In the Office Action, the Examiner states that base plate 11 (actually slide 11 in Welp) is secured to the floor via member (traverse in Welp) 9 and the "framework" of the machine. Assuming *arguendo* that Welp teaches a floor, the Examiner has not specified what the Examiner considers to be "the framework." Welp does not use this term in the specification and the drawings do not shown any element labeled as a framework. Therefore, the Examiner's assertion that slide 11 is connected to a monolithic "framework" has no support in Welp. Figure 1 of Welp shows shaft structures apparently connected to traverses 9 and 10, respectively. These shafts extend vertically and are truncated at the top of the drawing. Neither the specification nor Figure 1 state or show to what the shafts are connected. For example, col. 3, lines 10 – 22, which describe the arrangement of the traverses do not specify anything other than that the traverses are "raisable and lowerable" (line 11). Thus, it is possible that the shafts are connected to components not even shown in Figure 1. Clearly, nothing is specified regarding if or how any such components are secured. Further, the unknown connection of the aforementioned shafts could entail an even larger number of components.

c.) Welp does not teach securing his machine to a floor

In the Office Action, the Examiner states that base plate 11 (actually slide 11 in Welp) is secured to the floor via member (traverse in Welp) 9 and the framework of the machine. Appellants have shown that Welp does not teach a framework. However, assuming *arguendo* that Welp does teach a framework and the preceding linkage of components is correct, Welp is silent as to whether the framework is secured in any manner. Assuming *arguendo* that Welp's framework is secured to another structure, there is no teaching that the structure is a floor. Any number of arrangements

could be used to secure the framework and many of the possible arrangements do not involve securing the framework to a floor. For example, Welp's machine could be supported by legs or stanchions that are not secured to a floor. Thus, there is no basis for the Examiner's assertion that Welp's framework is secured to a floor.

d.) The Examiner is reaching with respect to the definition of "secured."

Assuming *arguendo* that Welp teaches that the slide 11 is connected to a framework and that the framework is connected to a floor, the Examiner is reaching and straining the bounds of credibility to assert that the complicated linkage of slide 11 to traverse 9 and an unspecified "framework" is consistent with the recitation of "secured to a floor" in Claim 1. In the Office Action, the Examiner has cited Butterworth (USPN 6,547,909) and Slezak (USPN 6,691,945) to support the Examiner's assertion that "secured" means "attached in some manner" unless it is further qualified. According to the Examiner's assertion, the qualifier "directly" would need to be associated with every recitation of the limitation "secured" to avoid the possibility of an unlimited number of intervening components. Appellants submits that "secured to" inherently means directly secured to and further qualification is used to provide information regarding the manner of the direct attachment or to signify an attachment through a plurality of intervening parts. For example, Butterworth states: "Each idler roll 32, 34, 40, 42, 44 and 46, is positioned and secured for rotation in a conventional manner." (col. 5, lines 42-44). Upon viewing Figure 1 of Butterworth, it is clear that there is no intention for the idlers to be indirectly connected through a labyrinth of interceding parts and that "for rotation" describes the desired operation arising from the inherently direct connection.

Slezak states: "On the outboard end of the pivot shaft 15, i.e., away from the plate 20, the elongated, curved control lever assembly 13 is non-rotatably secured." (col.4, lines 34-39). "The loading lever assembly 14 is non-rotatably secured at one end of the pivot shaft 15,..." (col. 4, lines 66-67). "Each positive flange engagement mechanism 85 includes a slide tube 86 which is secured to the ears 77 by a pair of retaining rings 87, 87." (col. 6, lines 40-43). From the examination of Figures 1 and 2, it is clear that the secured items are directly secured and the qualifier provides

further information regarding the operation of the secured item. The qualifier does not describe an indirect securement. For example, the direct securement of assembly 14 is non-rotating.

As noted *supra*, Claim 1 recites: “a base plate operatively arranged to be secured to a *floor* (emphasis added);” This connection of the base plate to a floor is shown in Figure 1 of the present application. Claim 1 does not recite any limitations, such as “indirectly secured to a floor” that would obviate the plain meaning of “secured to a floor,” as shown in Figure 1 of the application. That is, the item secured to the floor is in contact with the floor and fastened to the floor. However, in the Office Action, the Examiner states that base plate 11 (actually slide 11 in Welp) is secured to the floor via member (traverse in Welp) 9 and the framework of the machine. Assuming *arguendo* that Welp teaches a floor, the Examiner has proposed a definition of “secured” that is indefensibly broad. That is, the Examiner proposes that connecting first and second objects to a myriad of objects disposed between the first and second objects is identical to connecting the first object to the second object. Thus, following the logic of the Examiner’s definition, the only items that are not connected to a floor at some point, regardless of the number of intervening items, are suspended above the floor, for example, suspended in midair by magnetic force, compressed air etc. However, the Examiner’s definition could even cover these cases, since the definition would consider the compressed air or the magnetic field as a connecting link. As another example of the Examiner’s definition in practice, an antenna on the roof of a five story building would be connected to a basement floor of the building due to the connection of the antenna to roof sheathing, roof members, wall and floor members etc., one of which ultimately is directly connected to the floor. The upshot is that the word “secured” would have no meaning in the art or in patent law if the Examiner’s definition were accepted.

e.) Welp does not teach a free-standing device

“Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).” See MPEP 2111.02.

The preamble of Claim 1 recites: “A *free-standing* (emphasis added) coil reel hold-down device, comprising:” The free-standing nature of the device recited in Claim 1 is shown in Figure 3-5 of the present application. Thus, the aforementioned preamble clearly limits the structure of the claimed invention. That is, there is a clear structural difference between a unit that is free-standing with respect to another unit and a unit that is integral to another unit.

Assuming *arguendo* that, as asserted by the Examiner, Welp’s coil reel hold-down device comprising arm 13 having first and second sections, an arm pivoted to “base plate” 11 secured to a floor via members 9 and the frame of the machine, and being moved by a cylinder device to engage wheel/roll 15 with the roll 3 is analogous to the coil reel hold-down device recited in Claim 1, Welp clearly teaches that the device is integral to a larger/other machine. For example, in Figure 1, Welp shows arm 13 and elements 9 and 11 as being part of a larger machine.

The Examiner has admitted that Welp is not free-standing. For example, in the Office Action, the Examiner states that base plate 11 (actually slide 11 in Welp) is secured to the floor via member (traverse in Welp) 9 and the framework of the machine. That is, the Examiner acknowledges that the alleged coil reel hold-down device of Welp is intricately connected with other parts of a larger machine.

f.) Welp does not inherently teach the elements of Claim 1

“However, when relying on ‘inherency,’ the examiner must show or establish that the desired properties or characteristics *necessarily* flow from the teachings of the prior art.” *In re Robertson*, 169 F. 3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Appellants have shown *supra* that Welp does not expressly teach a floor, securing a slide to a framework, or securing his device to a floor. None of the aforementioned limitations necessarily flow from the teachings of Welp. As noted *supra*, Welp’s device can be secured to structural elements other than a floor, for example, beams over a pit, or can be “unsecured” with respect to a structural element. For example, the device can be supported by stanchions resting, but not connected to, a floor. Nor does the Examiner’s definition of “secure” necessarily flow from the teachings of Welp.

Welp does not describe each and every element of the invention recited in Claim 1, either expressly or inherently. Therefore, Claim 1 is novel with respect to Welp. Claims 2-12, dependent from Claim 1, enjoy the same distinction from Welp.

Appellants courteously request that the rejection be reversed.

3. Whether Claims 7, 8, and 12 are non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over Welp et al. (USPN 5,518,199)?

A.) Summary of the Rejection: In the Office Action, the Examiner rejected Claims 7, 8, and 12 under 35 U.S.C. §103(a) as being unpatentable over Welp et al. (USPN 5,518,199). In the Office Action and in an Office Action dated December 15, 2004, the Examiner stated: "The particular type of cylinder used to pivot the arm of Welp et al and the particular angular range of movement of the arm would have been obvious design considerations to one of ordinary skill for reasons presented previously in the prosecution of the application."

B.) The References cited by The Examiner: For purposes of providing background, Appellants briefly discusses the references cited by the Examiner.

1.) Welp: (Appellants have assigned numerical designators when possible, however, this was not always possible due to inconsistencies in the nomenclature used by Welp) Elongated support roller 5 is centered on and rotatable about horizontal axis A and radially engages at least one row of takeup rolls 3 coaxial to a takeup-roll axis parallel to support-roller axis A and including at least one central roll and a pair of end rolls axially flanking the central roll. A paper web 1 is fed to the support roller and passes through cutting device 6 between the web supply and the support roller for slitting the web into a plurality of strips including at least one central strip and a pair of end strips flanking the end strip. The central and end strips pass at least partially around the support roller and are wound on the respective central and end rolls. The support roller is rotated about its axis so that the strips wind at least partially around the support roller and at least the central

roll is rotated by engagement with the support roll. Respective end-roll periphery drives 17 and 18 radially engage the end rolls for rotating same at a greater peripheral speed than the support roller.

C.) Arguments

1.) Claim 1 is patentable over Welp

a.) The Examiner admitted that Claim 1 is patentable over Welp

The Examiner applied the obviousness rejection only to Claims 7, 8, and 12, thereby admitting that Claim 1 is patentable over Welp.

b.) Welp does not teach, suggest, or motivate the elements of Claim 1

“There are three requirements to establish a *prima facie* case of obviousness: there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; there must be a reasonable expectation of success; and, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellants’ disclosure.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1483 (Fed. Cir. 1991).”

Appellants have shown *supra* that Claim 1 is novel with respect to Welp. Specifically, Welp does not teach all the limitations of Claim 1, in particular: “a base plate operatively arranged to be secured to a floor.” For example, Welp contains no teaching with respect to a floor, a framework, and securing his machine. Nor does Welp suggest or motivate the aforementioned limitations.

For all the reasons noted *supra*, Claim 1 is patentable over Welp.

2. Claims 7, 8, and 12, dependent from Claim 1 are patentable over Welp

“If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 7, 8, and 12 depend from Claim 1. Therefore Claims 7, 8, and 12 are patentable over Welp.

Appellants courteously request that the rejection be reversed.

Conclusion

For the reasons set forth above, Appellants respectfully submit that Claim 6 satisfies the requirements of 35 U.S.C. § 112, second paragraph.

For the reasons set forth above, Appellants respectfully submit that Claims 1-12 are novel with respect to Welp et al. (USPN 5,518,199).

For the reasons set forth above, Appellants respectfully submit that Claims 7, 8, and 12 are non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over Welp et al. (USPN 5,518,199).

Accordingly, Appellants prays that this Honorable Board will reverse the Examiner's rejection of Claims 1-12.

Respectfully submitted,



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Dated: October 18, 2005
CPM/
Attachment

CLAIMS APPENDIX

Reprinted herebelow are the claims involved in this appeal:

1. A free-standing coil reel hold-down device, comprising:
 - a base plate operatively arranged to be secured to a floor;
 - a snubber arm having integral first and second sections arranged at an obtuse angle to one another, said snubber arm pivotably mounted to said base plate at a first end of said first section of said snubber arm and arranged for pivoting rotation about a pivot point proximate said base plate; and,
 - an actuator mounted to said base plate, and arranged to effect a pivoting movement of said snubber arm relative to said base plate, wherein said actuator is connected to said first section of said snubber arm between said pivot point and said second section of said snubber arm.
2. The coil reel hold-down device recited in Claim 1 wherein said first section of said snubber arm is disposed proximate said base plate.
3. The coil reel hold-down device recited in Claim 1 further including a snubber device mounted to said second section of said snubber arm.
4. The coil reel hold-down device recited in Claim 3 wherein said snubber device comprises a wheel.
5. The coil reel hold-down device recited in Claim 3 wherein said snubber device comprises a roller.
6. The coil reel hold-down device recited in Claim 1 in which said means for effecting a pivoting movement of said snubber arm comprises a cylinder.
7. The coil reel hold-down device recited in Claim 6 wherein said cylinder is pneumatically controlled.
8. The coil reel hold-down device recited in Claim 6 wherein said cylinder is hydraulically controlled.
9. The coil reel hold-down device recited in Claim 1 wherein said obtuse angle is approximately 120 degrees.

10. The coil reel hold-down device recited in Claim 1 wherein said first section has a first length and said second section has a second length wherein said first length is approximately three times said second length.

11. The coil reel hold down device recited in Claim 1 wherein said obtuse angle is in a range of about 100 to 130 degrees.

12. The coil reel hold down device recited in Claim 1 wherein said snubber arm is arranged to pivot about said pivot point through an angle in a range of approximately 25 to 40 degrees.

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EVIDENCE APPENDIX

No additional evidence is being submitted with this appeal.

Serial No. 09/954,766
Attorney Docket No. ELRP:101_US_
Brief on Appeal dated October 18, 2006

RELATED PROCEEDINGS APPENDIX

Upon information and belief, no appeals or interferences are known to Appellants, which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.